

**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**  
**Trademark Trial and Appeal Board**  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

twv

Mailed: April 4, 2002

Opposition No. 32,341

PRAMIL S.R.L.

v.

MICHEL FARAH

Thomas W. Wellington  
Interlocutory Attorney, Trademark Trial and Appeal Board:

This case now comes up on respondent's motion (filed January 8, 2002) to take oral deposition of petitioner instead of upon written questions.

A discovery deposition of a natural person who resides in a foreign country, and who is a party, or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under FRCP 30(b)(6) or 31(a)(3) to testify on behalf of a party, must be taken upon written questions, in the manner described in 37 CFR §2.124, unless the Board, upon motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination. See 37 CFR §2.120(c)(1). See also *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989); *Jonergin Co. v.*

*Jonergin Vermont Inc.*, 222 USPQ 337 (Comm'r 1983); Saul Lefkowitz and Janet E. Rice, Adversary Proceedings Before the Trademark Trial and Appeal Board, 75 Trademark Rep. 323, 384 (1985); Rany L. Simms, TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board, 75 Trademark Rep. 296 (1985); and Janet E. Rice, TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules, 74 Trademark Rep. 449 (1984).

Essentially, respondent argues in its motion that the instant case "amounts to counterfeiting litigation being held before this Board, instead of a Court of law, wherein the Parties' contentions are likely to be determined based at least in part upon the credibility of testimony." Respondent bases this assertion on petitioner's allegation that respondent made knowingly false and fraudulent statements to the Office concerning its dates of first use of its mark. Respondent therefore concludes that petitioner cannot be expected to provide "complete, non-evasive answers to written questions in the context of this 'counterfeiting' litigation" and an oral deposition is "crucial to defeating factual allegations believed to be false or incomplete."

Petitioner has opposed respondent's motion. Petitioner argues that respondent has failed to show any "exceptional circumstances" requiring an oral deposition and the costs involved in conducting such a deposition would outweigh any

any inconvenience caused by the deposition upon written questions procedures. Petitioner, an Italian company, furthermore states that it has no "immediate plans" for a representative to be in the United States with the discovery period.

The Board has reviewed the parties' arguments and finds that respondent has failed to make a showing of good cause for taking the discovery deposition orally of petitioner, a foreign entity. Respondent's characterization of this proceeding as "counterfeiting litigation" and argument that petitioner will not likely respond to a deposition upon written questions with complete, non-evasive answers are not well-taken. Accordingly, respondent's motion to take oral deposition of petitioner is hereby denied.

Respondent's motion (filed February 7, 2002) for an extension of time, with petitioner's consent, is hereby granted; accordingly, the deadline for discovery and trial dates are hereby reset as set forth in said motion.

***By the Trademark Trial  
and Appeal Board***